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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/947,668 10/09/97 SLEMKER

T 534128-002-C

EXAMINER

QM12/0911

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ART UNIT

PAPER NUMBER

3738
DATE MAILED:

6
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/947,668

Applicant(s)

SLEMKER, TRACEY C.

Examiner

Michael J Milano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 1998.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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DETAILED ACTION

Response to Amendment

Applicant's Preliminary Amendment filed January 05, 1998 was entered into the application after the mailing of the May 12, 1998 Office action. The May 12, 1998 Office action is hereby **withdrawn**. Applicant need not respond to the May 12, 1998 Office action. A new Office action follows.

Interference

Claims 37-42 of this application have been copied by the applicant from U. S. Patent No. 5,658,353. These claims are not patentable to the applicant because the claims are rejected over prior art as stated in the below rejection of the claims.

An interference cannot be initiated since a prerequisite for interference under 37 CFR 1.606 is that the claim be patentable to the applicant subject to a judgment in the interference.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 37 and 38 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 07155343 (JP '343). JP '343 teaches the use of a method for donning and doffing a suction suspension apparatus comprising decreasing the air pressure to a negative pressure to draw the limb into the socket and increasing the air pressure to a positive

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pressure to expel the limb from the socket (see page 5, paragraphs 2-3 of the English Translation).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '343. JP '343 teaches all aspects of the claimed invention except for the specific use of a lubricant (applicant's claims 39 and 40) and the installation of a valve in the socket (applicant's claims 40-42).

JP'343 teaches that it is well known in the prior art devices to use lubricant (talc) to facilitate the insertion of the stump into the socket (page 3, section 1 of Translation). Talc is also widely used in suction type sockets because it absorbs moisture, helping to maintain the suction. One of the features of the JP '343 invention is the ability of the suction pump to overcome the friction caused by an un-lubricated stump, thus eliminating the added step of applying lubrication (talc) to the stump. JP '343 does state that the suction will need to be adjusted when the socket becomes loose by sweat (page 6, lines 9-14 of Translation). Since talc has known lubricating and sweat absorption characteristics, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied talc (lubricant) to the stump of JP '343 to facilitate the insertion of the stump into the socket and to dry any sweat present

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on the stump. It is noted that JP '343 teaches away from the use of lubricant but the use of the lubricant will not make the JP '343 device defective. Talc was only desired to be eliminated so fewer steps could be performed by the user while applying the prosthesis. Even though talc is no longer required with the JP '343 device, the use of talc will still provide beneficial effects at the risk of adding another step to the donning process of the prosthesis.

Applicant's claims 40-42 recite the additional step of installing a quick release valve in the socket. The valve engages a piece of tubing, which is connected on the opposite end to a pump. JP '343 teaches that the suction pump 2 is connected to a tube and the tube is installed in the socket. The pump 2 inherently contains a valve in order for the negative pressure to be maintained. A known mechanical equivalent to a single unit containing the pump and valve would be a distinct and separate pump and valve. There are advantages and disadvantages to both systems but the resultant functions would be the same. Therefore, to have substituted a separate pump and valve configuration for an integral pump/valve system would have been obvious to one of ordinary skill in the art at the time the invention was made because the integral pump/valve system or separate pump and valve elements would have been known functional equivalents. Furthermore, the location and selection of a well-known "quick release" valve in the socket in the JP '343 device would have been an obvious matter of design choice because they would have performed equally well in the JP '343 device.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J Milano whose telephone number is 703-308-2496. The examiner can normally be reached on M,T,TH,F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corinne McDermott can be reached on 703-308-0858. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Michael J Milano
Primary Examiner
Art Unit 3738

mjm
September 6, 2001


E. Rollins-Cross
Director, Group 3700

Attachment for PTO-948 (Rev. 03/01, or earlier)

6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.